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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,136	10/12/2001	Wolfgang Reik	3191/OJ838	7044

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EXAMINER

SMITH, JULIE KNECHT

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 01/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/982,136

Applicant(s)

REIK ET AL.

Examiner

Julie K Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Invention I in Paper No. 6 is acknowledged, however, no arguments for traversal were submitted. Therefore, election is considered without traverse. Claim 6 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Invention III, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 7-8 and 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hardeman (5,267,488).

Regarding claims 1-3, Hardeman discloses a motor vehicle (V) comprising an engine with and engine block, a clutch (12) with a clutch actuator device including a hydraulic element (60), the clutch actuator device including a clutch release device (36) with a clutch release drive source (62). Hardeman further discloses a transmission (46) adjacent to the clutch, a transmission housing, a clutch bell housing (28), a control device and a carrier element (10),

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wherein the transmission housing is connected to the clutch bell housing and the clutch bell housing is connected to the engine block (see fig. 1). The control device is operable to control the clutch in an automated mode. Hardeman further discloses said carrier element arranged in an intermediate area between the clutch bell housing and the transmission housing (see fig. 3). The clutch release drive source and the clutch release device are both integrated in the carrier element (see col. 5, lines 5-8).

Regarding claims 7-8, Hardeman discloses a carrier element (10) that functions as a rear wall that closes off the clutch bell housing towards the transmission. Hardeman further discloses a clutch bell housing (28) comprising a rear housing wall (22) and the carrier element is arranged to lie against the rear housing wall.

Regarding claim 12, Hardeman discloses the clutch bell housing (28) and the transmission housing being made as separate components and the carrier element forms a connection between the housings.

Regarding claim 13, Hardeman discloses the clutch bell housing and the transmission housing being connected as a housing unit and the carrier element is arranged inside the housing unit in a transition area between the clutch bell and transmission housing (see fig. 3).

Regarding claims 14-16, Hardeman discloses a carrier device (10) forming an assembly unit that is preassembled. Claims 14-16 are product-by-process claims and are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is

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unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardeman as applied to claims 1-3, 7-8 and 12-16 above, in view of Machida et al. (4,719,812). Hardeman discloses a clutch housing assembly comprising mechanical elements integrated into the carrier unit, as claimed, but is silent as to hydraulic elements being integrated within the housing. However, Machida et al. teaches a clutch actuator device (3) comprising hydraulic conduits and hydraulic elements, such as a valve and cylinder (11, 12, 13, 17).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the housing of Hardeman with the teachings of Machida et al. to replace the mechanical elements with hydraulic components, as it is old and well known in the art that hydraulic elements are found in clutch housings, along with mechanical and electrical components.

6. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardeman in view of Machida et al. as applied to claims 4-5 above, and further in view of Burkett (5,566,591).

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Hardeman discloses a carrier element, as claimed, but is silent as to the manufacture of the housing. However, Burkett teaches a carrier element (28) made as a steel casting (see col. 6, lines 26-31). Burkett further teaches actuator parts that are integrally molded into the casting.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the carrier element by casting as it is old and well known in the art to use casting as a method of manufacture.

Moreover, claims 9-11 are product-by-process claims and are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,009,125 to Machida et al.

5,127,287 to Taniguchi et al.

5,012,909 to Machida et al.

4,823,637 to Taguchi et al.

6,073,517 to Pauwels et al.

3,517,789 to Gimmler et al.

4,641,547 to Stich et al.

4,887,344 to Kurihara et al.

4,506,561 to Hayakawa

6,250,411 to Nesbitt et al.

4,057,134 to Gatewood

GB 2 282 786 to Smith

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Smith whose telephone number is 703-305-3948. The examiner can normally be reached on Monday-Friday, 8-5:30, (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Bucci can be reached on 703-308-3668. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

JKS

jks

January 9, 2003

  
CHONG H. KIM  
PRIMARY EXAMINER